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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/817,387

03/26/2001

Eckart Matthes

101195-24

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27387

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09/05/2008

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EXAMINER

EPPS FORD, JANET L

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

09/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/817,387	MATTHES ET AL.	
	Examiner	Art Unit	
	Janet L. Epps-Ford	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7,9-11 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,9-11 and 16-22 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

Response to Arguments

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. 1, 2, 5-7, 9-11 and 16-22 are presently pending in the instant application.

Claim Rejections - 35 USC § 112

3. The rejection of claims 9-11, 17 and 19-21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is withdrawn in response to Applicant's amendment filed 5-30-08.

Claim Rejections - 35 USC § 102

4. The rejection of claims 1, 5, 9-11, and 19-22 under 35 USC 102(b) is withdrawn in response to the observation that the compounds of Iversen et al. are phosphorothioate modified oligonucleotides, and do not comprise an additional phosphodiester region at the 3' terminus of the oligonucleotide as set forth in formula III of the instant application.

Claim Rejections - 35 USC § 103

5. Claims 1-2, 5, 7, 9-11, 17-20, and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Uhlmann et al. and Nielsen et al. in view of Norton et al. (1996) and Mata et al., for the reasons of record.
6. Applicant's arguments filed 5-30-08 have been fully considered but they are not persuasive. First, Applicant's argued that because the prior rejection under 103(a) over

Uhlmann et al. in view of Norton et al. (1996) and Mata et al., that this was implicit acknowledgement that applicant was persuasive in overcoming the prior rejection. Contrary to Applicant's assertions, the prior rejection was withdrawn in order to add the Nielsen et al. reference in order to strengthen the examiner's position. Furthermore, Applicants argued that the basis of the instant rejection relies upon the issue whether the addition of Nielsen et al. adds disclosure that renders applicants claims obvious or whether Nielsen et al. is merely additive to the disclosure of the previously cited references in the withdrawn rejection. Applicants concluded that Nielsen et al. does not cure the combination of the previously cited references. Specifically, Applicants argued that the combined references do not teach that "n is at least 10 and not more than 20, and p is at least 3 and not more than 17." According to Applicants, at page 16 of the reply filed 5-30-08, the difference in the number of oligonucleotides cited in the prior art, in comparison to that set forth in the instant claims "*are the crux of applicant's invention.*" Applicants further argued that they reviewed Norton et al. and did not find an oligonucleotide of 15 nucleotides as suggested by the examiner. A full length copy of Norton et al. will be forwarded to Applicants; the table set forth on page 616 of this reference clearly sets forth telomerase binding oligonucleotides of at least 15 nucleotides in length.

Absent evidence of unexpected results, it would have been obvious to the ordinary skilled artisan to combine the teachings of the above-cited references in the design of the present invention. Absent evidence of any unexpected results, one of ordinary skill in the art would have been motivated to make the oligomers of the present

invention to comprise wherein n is at least 10 and not more than 20, and p is at least 3 and not more than 17, since the Uhlmann et al. clear teach that chimeric PNA/DNA oligonucleotides or any sequence can be readily prepared, and Norton et al. discloses the nucleotide structure of an oligomer (15 base pairs in length; i.e. satisfying n and p) that recognizes the RNA component of human telomerase and inhibits the activity of the enzyme. Absent evidence of unexpected results, since the general conditions of the claimed invention are disclosed in the prior art, the recitation of the limitations "wherein n is at least 10 and not more than 20, and p is at least 3 and not more than 17," merely represents a difference of merely a design choice.

7. Arguments of counsel may be effective in establishing that an examiner has not properly met his or her burden or has otherwise erred in his or her position. However, it must be emphasized that arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964).

Conclusion

8. Claim 6 remains objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet L. Epps-Ford/
Primary Examiner
Art Unit 1633

JLE